

AGILENT TECHNOLOGIES, INC.  
Legal Department, DL429  
Intellectual Property Administration  
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PATENT APPLICATION **1634**

ATTORNEY DOCKET NO. 10992125-2

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Andreas N. Dorsel et al.

Serial No.: 10/036,999

Examiner: Betty J. Forman

Filing Date: 12/21/2001

Group Art Unit: 1634

Title: INTERROGATING MULTI-FEATURED ARRAYS

COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- (X) Response/Amendment ( ) Petition to extend time to respond  
( ) New fee as calculated below ( ) Supplemental Declaration  
( ) No additional fee (Address envelope to "Box Non-Fee Amendments")  
( ) Other: \_\_\_\_\_ (fee \$ \_\_\_\_\_)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	17	MINUS	20	= 0	X \$18	\$ 0
INDEP. CLAIMS	4	MINUS	4	= 0	X \$84	\$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$280	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$410.00	3RD MONTH \$930.00	4TH MONTH \$1450.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit: 04/21/2003

Typed Name: Elizabeth Miller

Signature: Elizabeth Miller

Respectfully submitted,

Andreas N. Dorsel et al.

By Gordon M. Stewart

Gordon M. Stewart

Attorney/Agent for Applicant(s)

Reg. No. 30,528

Date: 04/21/2003



CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on April 21, 2003.

Elizabeth Miller  
Elizabeth. Miller

4/21/2003  
Date

ATTY DOCKET No. 10992125-2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Andreas N. Dorsel et al.      Group Art Unit:      1634  
Serial No.:      10/036,999      Examiner:      Betty J. Forman  
Filed:      12/21/2001  
Title:      INTERROGATING MULTI-FEATURED ARRAYS

Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

RESPONSE TO RESTRICTION

The Examiner is thanked for the Office Action mailed 03/20/03. The Action contained only a restriction requirement and the Examiner identified the following groups:

- Group I (claims 1-11) – to a method of scanning an array package in class 435/6;  
Group II (claims 12-17) – to an apparatus in class 435/283.1.

Applicants hereby elect Group I (claims 1-11) with traverse for the reasons discussed below.

In particular, the overriding requirement for any restriction is set out in M.P.E.P. §803:

“There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and

(B) There must be a **serious burden** on the examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02)." (emphasis added)

The Examiner has attempted to establish a *prima facie* case of a serious burden by pointing to a different classification in the art. The Examiner points to class 435/6 for the method and class 435/283.1 for the apparatus. Those classes are defined as follows:

Class 435 – molecular biology and microbiology

Subclass 6 - MEASURING OR TESTING PROCESS  
INVOLVING ENZYMES OR MICRO-ORGANISMS; COMPOSITION OR TEST  
STRIP THEREFORE; PROCESSES OF FORMING SUCH COMPOSITION OR  
TEST STRIP  
– Involving nucleic acid

Subclass 283.1 – APPARATUS

When the Examiner examines the method claims 1-11 she would nevertheless have to look in class 435/283.1 to conduct a search since patent references under 435/283.1 will likely also include reference to methods of use of the apparatus (since the use of the apparatus must be described or readily apparent to satisfy the utility requirement). Thus, there is no "serious burden" in examining the two groups together (indeed there will be little, if any, additional burden) since it is highly unlikely the Examiner will not look at references in 435/283.1 in any event.

Given the above, it is submitted that the restriction requirement should be withdrawn.

If the Examiner is of the view that there are any outstanding issues, she is invited to call Gordon Stewart at (650)485-2386.

Respectfully submitted,



Gordon M. Stewart  
Attorney for Applicants  
Reg. No. 30,528

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